REMARKS

Claim 7 has been amended. Claims 1-37 remain pending in the application. Reconsideration is respectfully requested in light of the following remarks.

Section 103(a) Rejection:

The Office Action rejected claims 1-3, 5, 6, 8, 9, 11, 12, 14-16, 18-22, 24-26, 28-31, 33, 34, 36 and 37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shelton et al. (U.S. Patent 6,418,471) (hereinafter "Shelton") in view of Maria et al. (U.S. Patent 6,092,110) (hereinafter "Maria"). Applicant respectfully traverses this rejection for at least the following reasons.

Shelton in view of Maria does not teach or suggest receiving a first request from a first computer to access the web site, and sending a request for information to the first computer, wherein the information comprises a first Internet address and a first time value corresponding to the first computer, as recited in claim 1. The Examiner refers to col. 6, lines 7-23 of Shelton in regard to these limitations of claim 1. This portion of Shelton describes the operation of the WTS server 144 which is part of Shelton's WTS (Web Tracking and Synching) mechanism. The WTS server in Shelton record browser activities from web browsers 114 on terminals 104. However, the WTS mechanism of Shelton is not described as ever requesting any information from terminals 104, let alone an Internet address and a time value. Neither col. 6, lines 7-23, nor any other portion of Shelton describes the WTS mechanism requesting an Internet address and a time value from any of the terminals. Note that the time values stored in session table 145 (Fig. 6) are not requested from the terminals 104. Shelton only describes the WTS mechanism as tracking browser activity that it receives from the terminals. Shelton does not teach that the WTS mechanism ever requests any information from the terminals or browsers. A similar argument applies in regard to independent claims 9, 12 and 15.

Furthermore, Shelton in view of Maria does not teach or suggest determining whether a matching record for the first Internet address and the first time value exists in the database, and identifying the first computer as a distinct user if the matching record does not exist in the database, as recited in claim 1. The Examiner refers to col. 8, lines 1-22, of Maria in regard to these limitations of claim 1. Maria teaches a dedicated packet filter whose only function is to filter data packets based on a list of IP addresses (col. 2, lines 28-31). The filter either forwards or discards data packets whose IP address matches an address on the list (col. 2, lines 33-38). Column 8, lines 1-22 describes a list server 70 for updating the lists for each packet filter. Applicant fails to see how Maria has any relevance to the claimed invention. The list-based packet filtering of Maria has no relevance to identifying distinct users accessing a web site as recited in claim 1. Furthermore, the packet filter in Maria only compares the IP address. Neither Maria nor Shelton teaches determining whether a matching record for the first Internet address and the first time value exists in the database. A similar argument applies in regard to independent claims 9, 15, 16, 19, 20, 26, 29, 30, 34 and 37.

Moreover, the Examiner has not provided a proper motivation to modify Shelton according to Maria. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so in the prior art. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). The question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 488 (Fed. Cir. 1984). The reason given by the Examiner to combine the references is that "it would be more efficient to update and log users interactions with a web sites which could aid in the determination in trends that the users interests will gravitate towards, which the host will be able to change an alter their web site to accommodate the use." The Examiner's reason to combine has no relevance to the list-based packet filter and list server of Maria. Furthermore, applying the packet filter of Maria to the web site in Shelton would only server to filter out browser interactions from terminals whose IP address was on the list. However, this would defeat the intended purpose of Shelton to

record all browser activity to the web site. If a proposed modification would render the prior art feature unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984). Therefore, the combination of Shelton and Maria is clearly improper.

Claims 4, 7, 10, 13, 17, 23, 27, 32 and 35 were rejected under 103(a) as being unpatentable over Shelton in view of Maria and further in view of Bodnar et al. (U.S. Patent 6,295,541) (hereinafter "Bodnar"). These claims are patentable for at least the reasons given above in regard to their respective independent claims.

Applicants also assert that numerous ones of the dependent claims recited further distinctions over the cited art. However, since the independent claims have been shown to be patentably distinct, a further discussion of the dependent claims is not necessary at this time.

CONCLUSION

Applicants submit the application is in condition for allowance, and notice to that effect is respectfully requested.

If any extension of time (under 37 C.F.R. § 1.136) is necessary to prevent the above referenced application from becoming abandoned, Applicant hereby petitions for such extension. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5596-00200/RCK.

Also enclosed herewith are the following items:

☒ Return Receipt Postcard

☐ Petition for Extension of Time

☐ Request for Approval of Drawing Changes

☒ Notice of Change of Address

☐ Fee Authorization Form authorizing a deposit account debit in the amount of $

for fees ( ).

☐ Other:

Respectfully submitted,

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